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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,709	08/18/2003	Patricia A. Stewart	02-2176	4375

8840 7590 11/04/2004

ECKERT SEAMANS CHERIN & MELLOTT, LLC  
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EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,709	STEWART ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 36-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Applicant's election without traverse of Group I, claims 1-35, in the reply filed on August 6, 2004 is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sato et al.

Sato et al., U.S. Patent 3,856,686, teach lubricant compositions comprising graphite fluoride in a base oil (column 1, lines 7-11) prepared by thoroughly mixing in a mixer (column 6, lines 30-33).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7, 9-13, 15-21, 23-29 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al.

Sato et al., U.S. Patent 3,856,686, teach lubricant compositions comprising graphite fluoride in a base oil (column 1, lines 7-11). Suitable base oils include, inter alia, animal and vegetable oils and fats (column 2, line 46 to column 3, line 13). The amount of graphite fluoride is from 0.5 percent by weight to 60 percent by weight (column 5, line 63 to column 6, line 8). Column 10, lines 39-44 of Sato et al. teach coating a mold for die-casting an aluminum-base

alloy. While the teachings of Sato et al. are not limited to the specifically claimed concentrations or base oils, it would have been obvious to one having ordinary skill in the art at the time the invention was made to follow the above teachings and arrive at the instantly claimed compositions.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Milliken et al.

Milliken et al., U.S. Patent 3,087,213, teach a method for the continuous and semi-continuous casting of ingots of aluminum wherein the mold is provided with a lubricant containing an organic  $\text{BF}_3$  carrier compound (column 1, lines 10-19).

Claims 2-4, 6, 8-12, 14, 16-20, 22, 24-28, 30, 32, 33 and 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Milliken et al.

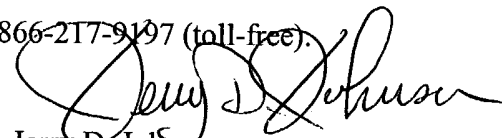
Milliken et al., U.S. Patent 3,087,213, teach a method for the continuous and semi-continuous casting of ingots of aluminum wherein the mold is provided with a lubricant containing an organic  $\text{BF}_3$  carrier compound (column 1, lines 10-19). The boron trifluoride content of the mold lubricant should be between 0.1 and 1.0 percent by weight of the entire composition (column 1, lines 64-67). The carrier may be of a mineral, animal or vegetable base, or a combination thereof (column 3, lines 62-64). While the teachings of Milliken et al. are not limited to the specifically claimed concentrations or base oils, it would have been obvious to one having ordinary skill in the art at the time the invention was made to follow the above teachings and arrive at the instantly claimed compositions.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jerry D. Johnson  
Primary Examiner  
Art Unit 1764

jdj